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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,069	08/06/2003	James Carl Schmidt	66192-0009	9856

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EXAMINER
WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

12 ✓

<b>Office Action Summary</b>	<b>Application No.</b> 10/636,069	<b>Applicant(s)</b> SCHMIDT, JAMES CARL	
	<b>Examiner</b> Anthony Weier	<b>Art Unit</b> 1761	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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### RESTRICTION REQUIREMENT

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14 and 40, drawn to a wafer product , classified in class 426, subclass 656.
  - II. Claims 15-18, drawn to a batter product, classified in class 426 subclass 656.
  - III. Claims 19, 20, 41, and 42, drawn to a snack product, classified in class 426 subclass 656.
  - IV. Claims 21 and 22, drawn to a method of making a wafer product , classified in class 426, subclass 656.
  - V. Claims 23-29, drawn to a method of making a batter product, classified in class 426 subclass 656.
  - VI. Claims 30-38, drawn to a method of making a snack product, classified in class 426 subclass 656.
  - VII. Claim 39, drawn to a diet, classified in class 514 subclass 560.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions **II** and **I** are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product ( MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct ( MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an edible material without cooking and forming a wafer or used in the preparation of a food product other than a wafer, e.g. pie crust and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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3. Inventions **III** and **II** are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product ( MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct ( MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an edible material without cooking or may be use in a food product other than a snack food (e.g. wafer cookie) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Inventions **III** and **I** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations ( MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the use of a wafer having at least 26% (to 99%) protein. The subcombination has separate utility such as a wafer cookie consumed alone without any of the other ingredients called for in the snack claims.

5. Inventions **IV** and **I/II/III** are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process ( MPEP § 806.05 (f)). In the instant case, the product (the wafer, the batter, or the snack) may be made by a process wherein whey protein and soybean protein are added to the batter at the same time and/or the batter is microwave cooked or fried.

6. Inventions **V** and **I/II/III** are related as process of making a batter product and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05 (f)). In the instant case, the product (either wafer, batter, or snack products) may be made by a process wherein whey protein is mixed with a portion of a solution of water, egg whites, and emulsifiers and the soybean protein is mixed with a second portion of said solution wherein the two mixture are then combined.

7. Inventions **VI** and **I/II** are related as process of making a snack and wafer/batter product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05 (f)). In the instant case, the wafer product (or batter) may be made by a process wherein the other

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snack ingredients set forth with respect to the claims of Invention VI are not included (e.g. cream filling).

8. Inventions VI and III are related as process of making a snack and snack product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05 (f)). In the instant case, snack may be made by a process wherein snack ingredients set forth with respect to the claims of Invention VI are included prior to cooking and/or forming of the wafer product.

9. Inventions I/II/III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the one invention involves a diet and the other refers to a wafer, batter or snack wherein said diet involves a system of eating whereas the wafer, batter, or snack are each individual elements used in the form of a snack within said system.

10. Inventions I/II/III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the one invention involves a diet and the other refers to a wafer, batter or snack wherein said diet involves a system of eating whereas the wafer, batter, or snack are each individual elements used in the form of a snack within said system.

11. Inventions I/II/III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the one invention involves a diet and the other refers to a wafer, batter or snack wherein said diet involves a system of eating whereas the wafer, batter, or snack are each individual elements used in the form of a snack within said system.

12. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the one invention involves the preparation of a batter and the other involves the preparation of a wafer wherein each invention resulting in different effects and different functions.

13. Inventions IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the one invention involves the preparation of a wafer and the other involves the preparation of a snack wherein each invention resulting in different effects and different functions.

14. Inventions IV/V/VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

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one invention involves a diet and the other inventions refer to process of making a wafer product, a batter product, or a snack product batter or snack wherein said diet involves a system of eating whereas the wafer, batter, or snack are each individual elements used in the form of a snack within said system.

15. Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the one invention involves the preparation of a batter and the other involves the preparation of a snack wherein each invention resulting in different effects and different functions.

16. Because these inventions are distinct for the reasons given above and the search strategy required for one group not required for any other group, restriction for examination purposes as indicated is proper.

17. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Friday.

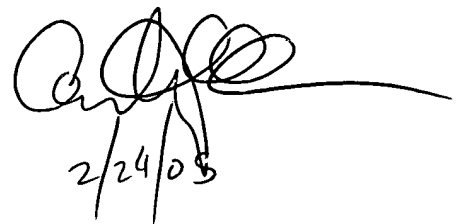
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached at 571-272-1398. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.

Anthony Weier

Primary Examiner

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2/24/05

Anthony Weier

2/24/05